

## **REMARKS**

### **I. Status of the Claims**

Claims 1-9 and 11-20 are pending in this Application. Claims 1 and 20 have been amended to correct typographical errors. Accordingly, no new matter has been introduced by this Amendment.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned "Version with markings to show changes made."

### **II. Claim Rejections Under 35 U.S.C. § 112**

The Examiner has rejected claims 1-9 and 11-20n under 35 U.S.C. § 112, second paragraph as allegedly indefinite for reciting the terms such as "antiinfective," "shaving preparations," "poison ivy products," "burn products," "anti-diaper rash agents," "prickly heat agents," "sensates," and "make-up preparations." The Examiner takes the position that these terms are not defined in the specification, and thus the metes and bounds of the scope of the claims are unascertainable. Applicants respectfully disagree.

Definiteness of claim language must be analyzed, not in a vacuum, but in light of (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See M.P.E.P. § 2173.02. Here, each of the benefit agents claimed are conventional active agents used in cosmetic compositions. Indeed, as discussed in the specification, the term "benefit agent" includes any active ingredient that is to be delivered into and/or onto a keratinous surface, such as, the skin, hair or nail at a desired location. See page 3, lines 27-28.

Further, the Specification teaches that the benefit agents useful in the present invention may be categorized by their therapeutic benefit or their postulated mode of action. Further, examples of suitable benefit agents for use in the present invention, are taught to include but are not limited to, those described in copending U.S. Patent Application Nos. 09/604,564 and 09/604449, filed concurrently on June 27, 2000, the disclosures of which have been incorporated by reference into the present specification. See page 10, lines 1-11.

One of ordinary skill in the art armed with the present disclosure, the teachings of the prior art and the claim interpretation that would be given by one possessing the ordinary level of skill in the art would clearly understand what ingredients are encompassed by the terms "antiinfective," "shaving preparations," "poison ivy products," "burn products," "anti-diaper rash agents," "prickly heat agents," "sensates," and "make-up preparations."

### **III. The Rejections Under 35 U.S.C. §103**

#### *A. The Rejection of Claims 1, 2, 3, 11-17 and 20*

The Examiner has rejected claims 1, 2, 3, 11-17 and 20 as allegedly unpatentable over U.S. Patent No. Herman, *Global Cosmetic Industry*, vol. 162, no. 2, pp. 22-24 ("Herman") in view of U.S. Patent No. 6,046,145 ("Santora et al.") and U.S. Patent No. 5,320,783 ("Marin et al.").

The Examiner relies upon Herman as disclosing the "that the basic components of ringing gel formulations are oil, water, a surfactant, and a cosurfactant." Herman fails to teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. There is nothing in the teachings of Herman that would provide one of ordinary skill in the art with the expectation that the ringing gel composition broadly disclosed by Herman could be used to deposit benefit agents to keratinous surfaces.

Recognizing these deficiencies, the Examiner relies upon Santora and Martin et al. Specifically, the Examiner relies upon Santora as teaching a cleansing and moisturizing surfactant composition comprising nonionic, amphoteric and anionic surfactants. The Examiner relies upon Marin et al. as disclosing a hexagonal liquid crystal composition comprising oily phase, surfactant system and water. The Examiner also relies upon Marin as teaching that the compositions taught therein provide good viscosity, foaming, stability, appearance and cleaning ability. According to the Examiner it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Herman and add the surfactants and cosmetic actives as suggested by Santora and motivated by Marin because of the expectation to have successfully produced a mild and non-greasy skin or hair care composition with viscosity, stability, appearance and good cleansing effects." Applicants respectfully disagree.

The Examiner has failed to provide any teaching or suggestion in either of Herman or Santora et al. that would provide one of ordinary skill in the art with the motivation to incorporate the ingredients taught by Santora et al. into the ringing gel compositions disclosed by Herman. The Examiner relies upon Marin as providing the requisite motivation. The fact that Marin teaches that the Marin compositions provide good viscosity, foaming, stability, appearance and cleaning ability, would not motivate one of ordinary skill in the art to incorporate the ingredients taught by Santora et al. into the compositions taught by Herman, much less, that the ringing gel composition broadly disclosed by Herman could be used to deposit benefit agents to keratinous surfaces.

Accordingly, Applicants respectfully submit that Herman, Santora et al. and Marin, taken alone or in any combination render the present claims obvious for the following reasons: (1) there is no suggestion or motivation in either of Herman, Santora et al. or Marin to modify the compositions of Herman as suggested by the Examiner; (2) even if one of ordinary skill in the art was somehow motivated to incorporate the ingredient taught by Santora et al. into the Herman ringing gel compositions, there is nothing in the teachings of Herman, Santora et al. or Marin that would provide a reasonable expectation that such a modification of the Herman ringing gel compositions would be successful; and (3) even if the references were combinable as suggested by the Examiner, all the claim limitations are not taught or suggested since each of Herman, Santora et al. and Marin fail to teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. Therefore, the rejection should be withdrawn.

*B. The Rejection of Claims 4-9*

The Examiner has rejected claims 4-9 as allegedly unpatentable over Herman, Santora and Marin et al. as applied to claims 1-3, 10-17 and 20 and further in view of U.S. Patent No. 4,940,577 ("Greenberg et al.").

The Examiner relies upon Greenberg et al. for teaching the specific oil phase recited by claims 4-9. Specifically, the Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the ringing gel composition taught by Herman by incorporating certain ingredients taught by Santora et al. and further modify the composition by incorporating specific esters taught by Greenberg et al. because of "the expectation to

have produced a clear microemulsion skincare composition with a smooth and non-tacky feel.”

Greenberg et al. fails to remedy the deficiencies of Herman, Santora and Marin as set forth above. There is nothing in the teachings of Greenberg et al., Herman, Santora, and Marin taken alone or in any combination, that would provide one of ordinary skill in the art with the motivation to incorporate the ingredients taught by Santora et al., Marin, and Greenberg et al. into the ringing gel compositions disclosed by Herman. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Here, the Examiner has failed to provide the requisite motivation for the combination. Further, since neither Santora et al. nor Greenberg et al. disclose ringing gel compositions, Applicants respectfully submit that there would not be a reasonable expectation that the ingredients taught by Santora et al., Marin, and Greenberg et al. could successfully be incorporated into ringing gel compositions.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for the following reasons: (1) there is no suggestion or motivation in any of the references relied upon by the Examiner to modify the compositions of Herman as suggested by the Examiner; (2) even if one of ordinary skill in the art was somehow motivated to incorporate the ingredient taught by Greenberg et al., Santora et al. and Marin into the Herman ringing gel compositions, there is nothing in the teachings of Greenberg et al., Herman, Marin or Santora et al., taken alone or in combination, that would provide a reasonable expectation that such a modification of the Herman ringing gel compositions would be successful; and (3) even if the references were combinable as suggested by the Examiner, all the claim limitations are not taught or suggested since none of the references teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. Accordingly, Applicants respectfully request that this rejection be withdrawn.

*C. The Rejection of Claims 1, 18 and 19*

The Examiner has rejected claims 1, 18 and 19 as allegedly unpatentable over Herman in view of U.S. Patent No. 5,256,396 (“Piechota”).

The Examiner relies upon Piechota for teaching a method for treating acne and the specific oil phase recited by claims 18 and 19. Piechota relates to topical compositions which

can be applied as a relatively low viscosity flowable liquid and which will quickly, upon contact with the warm surface of an animal, turn into a relatively high viscosity, essentially non-flowable, gel. Accordingly, the compositions taught by Piechota are distinct from the ringing gel compositions disclosed by Herman. Indeed, Picchota specifically teaches the disadvantages of compositions in the form of a gel prior to use. See col. 1, line 14 – col. 2, line 15.

It is the Examiner's position that it would have been obvious to one of ordinary skill in the art "to have modified the Herman's composition by adding retinoids or antimicrobial agents and used it to treat acne, as taught by Piechota, because of the expectation of successfully producing a ringing gel composition that may be used for acne treatment." Applicants respectfully traverse. Why would one of ordinary skill in the art be motivated to incorporate the anti-acne ingredients taught by Piechota into the ringing gel compositions taught by Herman when Piechota specifically teaches the disadvantage of compositions that are in the form of gels prior to use when applying active ingredients to humans and animals?

The Examiner states that Picchota discloses ringing gel compositions. Applicants respectfully disagree. Applicants remind the Examiner that references must be considered in their entirety. Clearly, Piechota is directed to compositions that are not in gel form until after applied to a desired situs. See, for example, col. 2, lines 11-15. Applicants have pointed out that the only disclosure in Piechota of ringing gels is at col. 3, lines 59-66. Here, Piechota is evaluating the effect of different poloxamers. Specifically, Piechota teaches that Pluronic F127 has the ability to form a ringing gel and as such "would not lead one skilled in the art to employ Pluronic F127 to meet the objects of this invention in that such teachings are totally inimical to the objects of this invention; it is taught that the result is a gelled solution at room temperature i.e. one that cannot be filled, stored or dispensed as a flowable liquid." See col. 3, line 66- col. 4, line 5 (emphasis added). Clearly, Piechota teaches away from compositions in the form of a gel prior to use.

The Examiner argues that "the disadvantage of using poloxamers is irrelevant in adding acne agents or antibacterial agents into the ringing gel of Herman for topical use" and that "the specific types of poloxamers referred by Piechota, Poloxmer 407, is neither a required limitation in instant claims or disclosed in Herman." Applicants respectfully submit that the Examiner has misunderstood Applicants' arguments. Applicants have pointed to this Example as evidence that Piechota teaches that composition for topical application in the

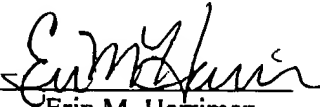
form of gels prior to use are not desirable due to flow problems. Clearly, one of ordinary skill in the art, armed with the disclosure of Piechota, would expect that the gel compositions taught by Herman would not be useful for delivering active ingredients, such as anti-acne agents, due to the fact that they are in the form of a gel. Thus, Piechota fails to provide the requisite motivation for incorporating an anti-acne active into the compositions of Herman. Indeed, Piechota specifically teaches away from such a modification due to flow problems. Accordingly, one of ordinary skill in the art would not have been motivated to combine the teachings of Piechota with the teachings of Herman. Applicants, therefore, respectfully request that this rejection be withdrawn.

#### IV. Conclusion

For the reasons set forth above, Applicants respectfully request withdrawal of all outstanding rejections. If the Examiner feels that a discussion with Applicants' representative would be helpful in resolving the outstanding issues, the Examiner is invited to contact Applicants' representative at the number provided below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750/JBP-529/EMH. If a fee is required for an Extension of time 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account 10-0750/JBP-529/EMH.

Respectfully submitted,

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Dated: March 5, 2003

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

Please amend claims 1 and 20 as follows:

2. (Twice Amended) A method of depositing a benefit agent on a keratinous surface, said method comprising topically applying to said surface an effective amount of a ringed gel composition comprising (a) a surfactant phase ; (b) an oil phase; and (c) a benefit agent; wherein the benefit agent is selected from the group consisting of vasoconstrictors, collagen enhancers, anti-edema agents, depigmentation agents; reflectants; detangling/wet combing agents; film forming polymers; humectants; [amino acid agents;] antimicrobial agents; allergy inhibitors; anti-acne agents; anti-aging agents; anti-wrinkling agents, antiseptics; analgesics; antitussives; antipruritics; local anesthetics; anti-hair loss agents; hair growth promoting agents; hair growth inhibitor agents; antihistamines; antiinfectives; inflammation inhibitors; anti-emetics; anticholinergics; [vasoconstrictors;] vasodilators; wound healing promoters; peptides, polypeptides and proteins; deodorants and anti-perspirants; medicament agents; skin emollients and skin moisturizers; skin firming agents, hair conditioners; hair softeners; hair moisturizers; vitamins; tanning agents; skin lightening agents; antifungals; depilating agents; shaving preparations; external analgesics; perfumes; fragrances; counterirritants; hemorrhoidals; insecticides; poison ivy products; poison oak products; burn products; anti-diaper rash agents; prickly heat agents; make-up preparations; vitamins; amino acids and their derivatives; herbal extracts; retinoids; flavenoids; sensates; anti-oxidants; skin conditioners; hair lighteners; chelating agents; cell turnover enhancers; coloring agents; pigments; sunscreens and mixtures thereof.
20. (Twice Amended) A method of cleansing and delivering a benefit agent to hair , skin or nails of a mammal, comprising topically applying to a desired location an effective amount of a ringed gel composition comprising (a) a surfactant phase; (b) an oil phase; and (c) a benefit agent; wherein the benefit agent is selected from the group consisting of vasoconstrictors, collagen enhancers, anti-edema agents, depigmentation agents; reflectants; detangling/wet combing agents; film forming polymers; humectants; [amino acid agents;] antimicrobial agents; allergy inhibitors; anti-acne agents; anti-aging agents; anti-wrinkling agents, antiseptics; analgesics; antitussives; antipruritics; local anesthetics; anti-hair loss agents; hair growth promoting agents; hair growth inhibitor agents; antihistamines; antiinfectives; inflammation inhibitors; anti-emetics; anticholinergics; [vasoconstrictors;] vasodilators; wound healing promoters; peptides, polypeptides and proteins; deodorants and anti-perspirants; medicament agents; skin emollients

and skin moisturizers; skin firming agents, hair conditioners; hair softeners; hair moisturizers; vitamins; tanning agents; skin lightening agents; antifungals; depilating agents; shaving preparations; external analgesics; perfumes; fragrances; counterirritants; hemorrhoidals; insecticides; poison ivy products; poison oak products; burn products; anti- diaper rash agents; prickly heat agents; make-up preparations; vitamins; amino acids and their derivatives; herbal extracts; retinoids; flavonoids; sensates; anti-oxidants; skin conditioners; hair lighteners; chelating agents; cell turnover enhancers; coloring agents; pigments; sunscreens and mixtures thereof.